

REMARKS

The Office Action of November 7, 2003 presents the examination of claims 17-53. The Examiner explains that the claims 18-54 were improperly numbered as a result of cancelation of claim 17 prior to entry into the U.S. National Stage. Accordingly, all claims are renumbered herein as claims 17-53. The present paper cancels renumbered claims 25-33 and 45. All other claims are amended to provide correct antecedent basis for the renumbered claims.

Support for amended claims

Claim 50 is amended to include an embodiment in which Z is defined as a CHR radical. Support for this amendment is provided at least by original claim 18 of the original PCT application and at page 19, line 30 ff.

Objections to the specification

The Examiner objects to the specification, at page 17, lines 6-27, asserting that the terms "E" and "l" are unclear. Applicants have deleted this portion of the specification, thus obviating this objection.

The Examiner objects to the specification at page 18, line 28, indicating that it is unclear what " $n + m - 4$ " refers to. This portion of the specification was corrected in the previous

Amendment to read, "n + m \leq 4". This phrase plainly refers to the valency of "R" in the formula (VIII) at line 20 of page 18.

The Examiner objects to page 20, line 27, indicating that "d = 0 or 1" causes confusion because d = 1 at page 20, line 18. The Examiner likely takes this position because for almost all definitions of "A", d = 1. The Examiner seems to have overlooked the definition of A at page 20, line 9, where d = 0.

Objections to the claims

Claims 17-41 and 50-53 are objected to as informal in the recitation of "ionically condensable compound" and "free-radical condensable compound". The substitution of the terms "ionically polymerizable" and "free-radical polymerizable" in claims 17 and 19 as suggested by the Examiner has been adopted.

Claim 40 (renumbered to claim 39) is objected as not further limiting the claim from which it depends. Claim 39 has been amended to recite dependence from claim 36, thus obviating this objection.

Claim 50 (renumbered to claim 49) is objected to as incorrectly reciting instances in which A = COOH. This claim has been amended to recite such instances as A = COO as suggested by the Examiner, thus overcoming this rejection.

Rejections under 35 U.S.C. § 112, first paragraph

Claims 25-40 stand rejected under 35 U.S.C. § 112, first paragraph, for alleged lack of adequate written description or enablement of the claimed subject matter. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

Claims 25, 27, 29 and 45 are rejected for lack of support for the definitions of the groups of E and x. These claims have been canceled, rendering this rejection moot. Notwithstanding cancellation of the claims, Applicants note that it is apparent from the specification that the moiety E is described as a straight or branched chain alkenyl moiety of 5 to 50 carbon atoms and having one or two double bonds under certain structural constraints upon the remainder of the claimed molecule. The Examiner's comment seems to be based upon a lack of explicit description of the moiety E' in the specification, which is simply intended to indicate that the moiety is E is a radical derived from a complete molecule. Applicants submit that nevertheless the meaning and scope of the moiety E in claim 25 as described in the specification is readily apparent to the skilled artisan.

Claim 36 is rejected for lack of description of the term "acyloxy". To the contrary, X in formula (VIII) of claim 36 is defined at page 18, line 24 as "hav[ing] the above". Originally

filed claim 9, by reference to "claims 1 or 2" makes clear that "the above" refers to the definitions provided in formula (I). Here (i.e. in formula (I)) "X" is recited as including "acyloxy" at e.g. page 2, line 22 of the specification.

Claims 42-49 are rejected on the grounds that the claimed subject matter is not described because the claim as written reads upon polymerization of the condensate precursors, not polymerization of the condensate products. Claim 42 is amended to recite, "... wherein 5 to 100 mol % based on monomeric compounds are selected from condensates of silanes of the formula I:...", thus obviating this rejection.

Claims 43 and 50 are asserted to lack support for the recitation that " $n + m < 4$ " or " $n + m \leq 4$ ". Applicants disagree.

The specification, at page 18, lines 20-27, provides the description of general formula (VIII). The formula is one of a silane compound, having radicals X, Y and R disposed about the silicon atom. It is clear to the skilled artisan that the valency of silicon is four. The description of formula (VIII) states the number of radicals X as 1, 2 or 3, the number of radicals Y as 1, 2 or 3 (at least in original claim 9) and the number of radicals R as the difference between 4 and the total of the number of radicals X and Y. Therefore, it is clear that the total of radicals X and Y

can be any integer from 2 to 4, accordingly, "less than or equal to 4" as recited in claims 43 and 50.

Claim 50 is rejected on the grounds that A should be defined as COO. Claim 50 has been so amended.

Claims 50-51 are rejected for alleged lack of enablement of embodiments other than mono- to tetra-valency. Applicants do not understand the basis for this rejection. The Examiner should note that c is shown as 1, 2, 3 or 4 and so the valency of G is commensurate with the scope of enablement suggested by the Examiner. While Applicants disagree with the Examiner's assertion that the claims must be limited to the scope of the working examples, the instances in which Z is C=O, d=1 and R²¹ is OH have been deleted from claim 50, thus obviating this ground of rejection.

Rejection over the prior art

Claims 17 and 52 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Yanagisawa JP '439. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

Applicants submit that the instantly claimed invention is distinct from what is disclosed by JP '439, at least in that the moiety U as defined in the instant claims 17 and 52 is not

disclosed in the reference. Accordingly, the instant rejection should be withdrawn.

The present application well-describes and claims patentable subject matter. The favorable action of allowance of the pending claims and passage of the application to issue is respectfully requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Mark J. Nuell (Reg. No. 36,623) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Appl. No. 10/031,612

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By Mark S. Nuell
Mark S. Nuell, #36,623

ADM/DRN/mua
0475-0199P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

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